

200.00 DA

A. 37 C.F.R. § 1.705(b)(2)(i) and (ii)

The patent term adjustment shown on U.S. Patent No. 6,897,305 B2 is 109 days.

Applicants respectfully submit that the correct patent term adjustment is 159 days. Specifically, when calculating the patent term adjustment for this patent, the USPTO erroneously included 50 days of Applicant delay because Applicants filed corrected drawings after a Notice of Allowance was mailed for this application. However, under the specific circumstances of this case, Applicants believe the filing of the corrected drawings did not constitute a failure to engage in reasonable efforts to conclude prosecution of the application. Accordingly, Applicants request that the 50 day reduction of patent term associated with Applicants' filing of the corrected drawings be removed. The basis on which Applicants seek adjustment is as follows.

(a) Period of Adjustment Pursuant to 37 C.F.R. §1.703(a)(3) and (6)

Applicants agree with the USPTO's determination, as shown in the Patent Application Information Retrieval (PAIR) system, that Applicants are entitled to 236 days of patent term adjustment due to USPTO examination delays. The total of 236 days is the sum of a delay of 24 days, (due to the USPTO's failure to respond within four months of Applicants' Reply, i.e., an Office Action was mailed on October 8, 2003, in response to Applicants' May 14, 2003 reply); and 212 days, (due to the USPTO failure to issue a patent not later than four months after payment of the issue fee, i.e., the Issue Fee was paid on June 4, 2004, and the patent issued on May 24, 2005) thus totalling 236 days.

(b) Period of Adjustment Pursuant to 37 C.F.R. 1.704

Applicants respectfully disagree with the USPTO's determination that the patent term adjustment should be reduced by 127 days due to Applicants' delays as indicated in PAIR. For the following reasons, Applicants respectfully submit that the correct patent term adjustment for Applicant delay should be 77 days instead of 127 days.

(b-1) Period of Adjustment Pursuant to 37 C.F.R. §1.704(b)

The USPTO has determined that the patent term adjustment for this application should be reduced by 77 days due to Applicant delay under 37 C.F.R. §1.704(b). Specifically, these delays consisted of a delay of 29 days (due to Applicants' failure to respond within three months to an Office Action, i.e., Applicants filed a response on May 14, 2003, to an Office Action dated January 15, 2003); and a delay of 48 days (due to Applicants' failure to respond within three months to an Office Action, i.e., Applicants filed an Amendment dated February 25, 2004, in response to a Final Office Action dated October 8, 2003), thus totalling 77 days. Applicants believe that this determination of 77 days of Applicant delay is correct.

(b-2) Period of Adjustment Pursuant to 37 C.F.R. §1.704(c)(10)

The USPTO has also determined that the patent term adjustment for this application should be reduced by 50 days due to Applicant delay under 37 C.F.R. §1.704(c)(10). Specifically, Applicants filed corrected drawings on April 5, 2005 (after a Notice of Allowance was mailed on March 26, 2004), and the patent subsequently issued on May 24, 2005, thereby resulting in 50 days of alleged Applicant delay. For the following reasons, Applicants believe the filing of the corrected drawings did not constitute a failure to engage in reasonable efforts to conclude prosecution of the application.

On March 26, 2004, a Notice of Allowance was mailed for this application. The Notice of Allowance indicated that "[t]he drawings filed on February 8, 1999 are accepted by the Examiner."

On June 24, 2004, Applicants timely paid the Issue Fee and Publication Fee for this application.

On March 17, 2005, the USPTO mailed a Notice Regarding Drawings indicating that corrections to the drawings were required. This notice was the first indication given to Applicants that corrected drawings were required and was **contrary** to the previous indication in the Notice of Allowance that the drawings were acceptable. The Notice Regarding Drawings set a two month period for response.

On April 5, 2005, Applicants timely filed corrected drawings that were accepted by the USPTO.

In view of the above facts, Applicants respectfully submit that Applicants' filing of corrected drawings in timely compliance with the Notice Regarding Drawing did not constitute a failure to engage in reasonable efforts to conclude prosecution of the application. Applicants acted in reliance on the indication in the Notice of Allowance that the drawings were acceptable and subsequently, complied in a timely manner to the request to correct the drawings initiated by the USPTO. Thus, Applicants believe they engaged in "reasonable" efforts to conclude prosecution of the application. Accordingly, Applicants respectfully request that the patent term adjustment for this application be corrected to 159 days, i.e., that Applicants not be penalized 50 days for submission of the corrected drawings.

B. 37 C.F.R. §1.705(b)(2)(iii)

This patent is not subject to a terminal disclaimer.

C. 37 C.F.R. §1.705(b)(2)(iv)

Applicants are not aware of any circumstances during the prosecution of this application that constitute a failure to engage in reasonable efforts to conclude processing or examination of this application as set forth in 37 C.F.R. §1.704.

D. Summary

In summary, U.S. Patent No. 6,897,305 B2 is entitled to a period of patent term of adjustment under 35 U.S.C. § 154(b) of 159 days (i.e., 236 days - 77 days). Therefore, Applicants respectfully request that this petition be granted and that this application be forwarded to the Office of Patent Publication for prompt issuance of a Certificate of Correction.

2. Fee Pursuant to 37 C.F.R. §1.18(e)

Pursuant to 37 C.F.R. §1.705(b)(1), a Fee Transmittal is enclosed authorizing the Commissioner to charge the Petition fee of \$200.00 set forth in 37 C.F.R. § 1.18(e) to deposit

account 50-0344. The Commissioner is also authorized to charge any additional fees or credit any overpayment to this deposit account. The Fee Transmittal is submitted in duplicate.

Should there be any questions concerning this paper, please contact the undersigned agent at (650) 808-6144.

Respectfully submitted,

Date: June 7, 2005

By: Joyce G. Cohen
Joyce G. Cohen
Reg. No. 44,622

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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Patent Number	6,897,305 B2	
	Issue Date	May 24, 2005	
	First Named Inventor	Yu-Hua Ji	
	Art Unit	1639	
	Examiner Name	M. Garcia Baker	
Total Number of Pages in This Submission		Attorney Docket Number	P-015-RP1

ENCLOSURES (check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):
Remarks Enclosed are the following documents: 1. Request for Reconsideration of Patent Term Adjustment Indicated on Issued Patent (37 C.F.R. §1.705) – 5 pages 2. Fee Transmittal for FY 2005 (1 page) and a duplicate copy 3. Receipt Postcard		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm	Theravance, Inc.		
Signature			
Printed Name	Joyce G. Cohen		
Date	June 7, 2005	Reg. No.	44,622

CERTIFICATE OF TRANSMISSION/MAILING			
I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service in an envelope addressed to: Commissioner for Patents, Mail Stop Petition, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.			
Signature			
Typed or printed name	Barbara Bryant	Date	June 7, 2005

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

Effective on 12/08/2004.

Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

**FEE TRANSMITTAL
for FY 2005**☐ Applicant claims small entity status. See 37 CFR 1.27**TOTAL AMOUNT OF PAYMENT** (\$) 200.00**Complete if Known**

Patent Number	6,897,305 B2
Issue Date	May 24, 2005
First Named Inventor	Yu-Hua Ji
Examiner Name	M. Garcia Baker
Art Unit	1639
Attorney Docket No.	P-015-RP1

METHOD OF PAYMENT (check all that apply)☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify) : _____☒ Deposit Account Deposit Account Number: 50-0344 Deposit Account Name: Theravance, Inc.

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☒ Charge fee(s) indicated below☐ Charge fee(s) indicated below, except for the filing fee☒ Charge any additional fee(s) or underpayments of fee(s)☒ Credit any overpayments

Under 37 CFR 1.16 and 1.17

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**FEE CALCULATION****1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee(\$)	Fee(\$)	Small Entity Fee(\$)	Fee(\$)	Small Entity Fee(\$)	
Utility	300	150	500	250	200	100	_____
Design	200	100	100	50	130	65	_____
Plant	200	100	300	150	160	80	_____
Reissue	300	150	500	250	600	300	_____
Provisional	200	100	0	0	0	0	_____

2. EXCESS CLAIM FEES**Fee Description**

Each claim over 20 (including Reissues)

Each independent claim over 3 (including Reissues)

Multiple dependent claims

Small Entity	
Fee (\$)	Fee (\$)
50	25
200	100
360	180
Multiple Dependent Claims	
Fee (\$)	Fee Paid (\$)
_____	_____

Total Claims **Extra Claims** **Fee(\$)** **Fee Paid (\$)**

_____ -20 or HP= _____ x _____ = _____

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims **Extra Claims** **Fee(\$)** **Fee Paid (\$)**

_____ - 3 or HP= _____ x _____ = _____

HP = highest number of independent claims paid for, if greater than 3.

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
_____	_____	_____	_____	_____


_____ - 100 = _____ / 50 = _____ (round up to a whole number) x _____ = _____

4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge) : Fee Code 1455: Petition fee for filing an application for patent term adjustment 200.00

SUBMITTED BY

Signature		Registration No. (Attorney/Agent)	44,622	Telephone	(650) 808-6000
Name (Print/Type)	Joyce G. Cohen	Date	June 7, 2005		

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing this form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.